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PERKINS COIE LLP
PATENT-SEA
P.O. BOX 1247
SEATTLE, WA 98111-1247

EXAMINER

FADOK, MARK A

ART UNIT PAPER NUMBER

3625

DATE MAILED: 08/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/318,447

Applicant(s)

HARTMAN ET AL.

Examiner

Mark A Fadok

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 49-107 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Amendment

The Examiner is in receipt of Applicant's response to Office action mailed March 14, 2002, which was received 7/15/2002. Since the Examiner did not address the claims cited in pre amendment dated 8/24/1999, the following new non-final Office action is provided.

Drawings

The drawings filed on 5/25/1999 are acceptable subject to correction of the informalities indicated on the attached "Notice of Draftperson's Patent Drawing Review," PTO-948. In order to avoid abandonment of this application, correction is required in reply to the Office action. The correction will not be held in abeyance.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 49-107 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims and specification of U.S. Patent

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No. 5,960,441. Although the conflicting claims are not identical, they are not patentably distinct from each other because the element which would be considered different (Ex. Web server, Http-response message, express ordering and an identifier stored as a cookie) are old and well known in the art and could have been used in the invention of Patent 5,960,441 if so desired.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 50,57,78 and 104 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The phrase "express ordering" is not found in the specification and therefore, cannot be clearly defined. For the purpose of this action, express ordering will be defined as an order, which is accelerated by the use of a single action (one-click of the mouse) verse multiple actions (multiple clicks of the mouse).

Claim 52, 70 and 103 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification describes the use of the invention with a shopping cart and also describes the to some degree reasons why a

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"shopping cart model" has disadvantages, but does not reveal or describe in detail the system/method without the use of a shopping cart, so the one skilled in the art could use the invention.

Further, a shopping cart is described Microsoft's computer dictionary (5th edition) as a file in which an online customer stores information on potential purchases until ready to order. Usually presented on the screen with a drawing of a shopping cart, the virtual shopping cart provides a recognizable point of reference to users new to the e-commerce experience. For the purpose of this office action the examiner understands that the information relating to the customers purchase is being stored in memory some where in the system for later retrieval to complete the sale and is therefore considered to be a commonly referred to "shopping cart model" without the use of the shopping cart symbol.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 52, 70 and 103 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 49, 53-56,60-62 are rejected under 35 U.S.C. 102(e) as being anticipate by Blinn et al (6,085,373).

In regards to claim 49, Blinn discloses a method for ordering an item via the Internet using a browser, the method including: under control of the browser at a client computer, receiving a selection of an item from a user (FIG 1); in response to receiving the selection of the item, displaying a web page containing a description of the selected item and a button for ordering the item; in response to the selection of the button by the user, sending to a web server an indication that the button was selected; under control of a web server, upon receiving the indication that the button was selected, retrieving information previously stored for the user; generating an order to purchase the item using the retrieved information; and sending a web page to the client computer indicating that the order has been generated; and under control of the

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client computer, displaying the sent web page that indicates that the order has been generated (col. 8, lines 35-45 and col 13, line 35 through col 22, line 14).

In response to claim 53, Blinn teaches wherein the sending to a web server of an indication includes sending an identifier of the user, wherein the web server uses the identifier to retrieve the information (**FIG 9**).

In response to claim 54, Blinn teaches wherein the identifier is stored as a cookie on the client computer (col 6, lines 64-67 and col 7, lines 1-4).

In response to claim 55, Blinn teaches wherein the item is a book. Blinn does not limit the kind of product that could be sold on its system and could therefore include books or any other product they so desire.

In response to claim 56, Blinn discloses an electronic commerce method for ordering an item, the method including: simultaneously displaying information identifying the item, an indication of an action to perform to add the item to a shopping cart, and an indication of an action to perform to order the item without further action (**FIG 4**); in response to performance of the action to add the item to a shopping cart, requesting that the item be added to the shopping cart; and in response to performance of the action to order the item without further action, requesting that an order for the item be placed (**FIG 4 and 3**) .

In response to claim 60, Blinn teaches wherein multiple orders are consolidated when the orders are placed within 90 minutes (**FIG 9**). Blinn does not specifically limit the amount of time that an order is outstanding before it can be consolidated; therefore the consolidation of orders as shown in FIG 9, could occur at any time including 90 minutes or less.

In response to claim 61, Blinn teaches wherein multiple orders for items that are available in three or fewer days are combined. Blinn teaches a database file that includes information about multiple purchases by different shoppers (includes identifier) along with the date created (FIG 7, col 23, lines 15-42). It is old and well known in the art to combine orders when possible to reduce shipping costs, therefore, since Blinn maintains the mechanics to accomplish this it is understood that Blinn could include this element if so desired.

In response to claim 62, Blinn teaches wherein when a server receives the request to place an order for the item, determining whether the server has enough information to place the order for the item, and when the server does not have enough information, providing a web page to collect additional information (col 13, line 35 through col 22, line 13).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 52, and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blinn.

In response to claim 52, Blinn teaches wherein the ordering is performed without using a shopping cart ordering model. Blinn teaches the claimed invention except for performing the ordering without using a shopping cart model. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to not use the shopping cart symbol to show where the information about a transaction is being stored, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

In response to claim 63, Blinn teaches wherein the provided web page includes a request for log on information. Blinn provides for a Shopper Identification number that uniquely identified the shopper (col 16, lines 1-15), but does not specifically mention the shopper logging in. It is old and well known in the art to include a log in request that asks the shoppers to identify themselves before furthering a transaction. Therefore, it would be obvious to a person of ordinary skill in the art to include in Blinn the logging in step, because this step would positively identify the

shopper and personal information about the shopper that is stored at the server could be retrieved rather than having the buyer reenter the information.

Claims 50,51,57,58,64-107 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blinn, and further in view of Trommer.

In response to claims 50,51,57,58,66,71,78,81,95,104 Blinn teaches wherein the ordering is a single action referred to as express ordering. Blinn teaches a method of conducting electronic commerce over the Internet where a display indication or "button" can be activated to purchase an item, but does not specifically mention a single action to enable the process. Trommer teaches a method that allows "one click commerce" (Para. 11). It would be obvious to a person of ordinary skill in the art to include in Blinn the single action as taught by Trommer, because having to click the object once simplifies the process. Please note that it is old and well known in the art that different methods of activating a display indication were available and could have been used in Blinn to activate an action by clicking a mouse, voice activation, a television remote, key on a key pad, pointing device, or a button. Blinn would be motivated to include these methods of activation, because the method presented in Blinn would be used on devices that don't have a mouse and would require this alternative method of activation.

In response to claim 59, Blinn teaches consolidating multiple orders placed in response to performance of the action to order the item without further action into a single order (see response to claim 50 and **FIG 10**).

In response to claim 64, Blinn discloses a computer-readable medium containing instructions for controlling ordering of an item, by receiving a request to display a description of an item (**FIG 12A**); and in response to receiving the request, providing a web page for simultaneously displaying a description of the item and an indication of a single action to perform to order the item and for (col. 8, lines 35-45 and col 13, line 35 through col 22, line 14)., in response to performance of the single action Blinn teaches a method of conducting electronic commerce over the Internet where a display indication or "button" can be activated to purchase an item, but does not specifically mention a single action to enable the process. Trommer teaches a method that allows "one click commerce" (Para. 11). It would be obvious to a person of ordinary skill in the art to include in Blinn the single action as taught by Trommer, because having to click the object once simplifies the process. Please note that it is old and well known in the art that different methods of activating a display indication were available and could have been used in Blinn to activate an action by clicking a mouse, voice activation, a television remote, key on a key pad, pointing devise, or a button. Blinn would be motivated to include these methods of activation, because the method presented in Blinn would be used on devices that don't have a mouse and would require this alternative method of activation., sending to a server computer a request to place an order for the item (**FIG 5**).

In response to claim 65, Blinn teaches wherein the provided web page is for simultaneously displaying an indication of an action to perform to add the item to a shopping cart along with the description of the item and the indication of the single

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action to perform and for, in response to performance of the action to add the item to a shopping cart, sending to a server computer a request to add the item to a shopping cart (see response to claim 56 and 64).

In response to claim 67, Blinn teaches wherein when multiple orders for items have been received, consolidating the orders (see response to claim 59).

In response to claim 68, Blinn teaches wherein orders placed within 90 minutes are consolidated (see response to claim 60).

In response to claim 69, Blinn teaches wherein orders for items to be delivered in three or fewer days are consolidated (see response to claim 61).

In response to claim 70, Blinn teaches wherein the item is ordered without using a shopping cart ordering model (see response to claim 52).

In response to claim 72, Blinn teaches wherein the request to place an order for the item includes an identifier of a purchaser (col 16, lines 1-14).

In response to claim 73, Blinn teaches wherein the identifier is stored at a client computer (col 6, line 64 through col 7 line 4).

In response to claim 74, Blinn discloses a computer-readable data

transmission medium including: a description of a web page for simultaneously displaying a description of an item to be ordered and an indication of a single action to perform to order the item and for in response to performance of the single action, sending to a server computer a request to place an order for the item (see response to claim 64).

In response to claim 75, Blinn teaches a description of a web page for confirming that an order for the item has been placed as a result of performance of the single action (col 19, line 65 through col 20, line 13).

In response to claim 76, Blinn teaches wherein the web page is for simultaneously displaying an indication of an action to perform to add the item to a shopping cart (**FIG 5**).

In response to claim 77, Blinn teaches wherein the description is sent as an HTTP-response message (col 13, lines 35-67).

In response to claim 79, Blinn teaches wherein the single action is clicking of a pointing device when a cursor is over a certain area (**FIG 5**).

In response to claim 80, Blinn discloses a method in a server system for placing an order for an item, including: receiving from a client system a request for a web page relating to an item; and in response to receiving the request, sending to the client system a web page for simultaneously displaying a description of the item and an indication of a single action to perform to order the item, and for, in

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response to performance of the single action, sending a request to place an order for the item (see response to claim 64).

In response to claim 82, Blinn teaches wherein when the order is placed without receiving billing information from the client system (**FIG 13, Item 1334**).

In response to claim 83, Blinn teaches wherein the web page is for simultaneously displaying an indication of an action to perform to add the item to a shopping cart (**FIG 5**).

In response to claim 84, Blinn teaches receiving from the client system an indication stored on the client system for identifying a purchaser of the item (col 6, line 64 through col 7, line 4).

In response to claim 85, Blinn teaches wherein the identifier is stored within a cookie (see response to claim 54).

In response to claim 86, Blinn teaches wherein items that are ordered by multiple performances of the single action are consolidated into a single order (see response to claim 59).

In response to claim 87, Blinn teaches wherein orders placed within 90 minutes are consolidated (see response to claim 60).

In response to claim 88, Blinn teaches wherein orders for items that are available within three days are consolidated for shipment (see response to claim 61)

In response to claim 89, Blinn teaches wherein the server system previously received and stored information that is used to place the order (**FIGs 7-9**).

In response to claim 90, Blinn teaches wherein the information includes delivery information (**FIG 7**).

In response to claim 91, Blinn teaches wherein the information includes billing information (**FIG 6**).

In response to claim 92, Blinn teaches wherein when the server system previously received the additional information, the server system effected the storing of an identifier on a client system (**FIG 7**).

In response to claim 93, Blinn teaches wherein the sent request includes the identifier (see response to claim 63).

In response to claim 94, Blinn discloses a method in a client system for placing an order for an item, including: displaying information identifying the item and displaying an indication of a single action to be performed to order the item; and in response to performance of the single action, requesting that an order be placed for the item (see response to claim 64).

In response to claim 96, Blinn teaches wherein when the order is placed without , receiving billing information from the client system when the order is placed (see response to claim 82).

In response to claim 97, Blinn teaches wherein the displaying is in response to receiving a web page (col 13, line 35 through col 20, line 24).

In response to claim 98, Blinn teaches wherein the web page is for simultaneously displaying an indication of an action to perform to add the item to a shopping cart (**FIG 5**)

In response to claim 99, Blinn teaches sending to server system an indication stored on the client system for identifying a purchaser of the item (see response to claim 54).

In response to claim 100, Blinn teaches wherein the identifier is stored as a cookie (See response to claim 54).

In response to claim 101, Blinn teaches wherein the requesting of multiple items within a certain time period results in the items being consolidated into a single order (see response to claim 59).

In response to claim 102, Blinn teaches wherein the requesting of multiple items within 90 minutes results in the items being consolidated into a single order (see response to claim 60).

In response to claim 103, Blinn teaches wherein the order is placed without using the shopping cart model (see response to claim 52).

105. The method of claim 94 wherein the single action is selecting of an area of a display using a pointing device (see response to claim 79).

In response to claim 106, Blinn teaches wherein the requesting includes sending information that can be used to identify a purchaser (see response to claim 54).

In response to claim 107, Blinn teaches requesting of multiple items results in the consolidation for shipment of those items that are available within three days (see response to claim 61).

Response to Arguments

The Examiner concurs with the Applicant that Claims 1-20 were erroneously prosecuted; while these claims were canceled in pre amendment dated August 24, 1999. Acknowledgement is made to amended claims 49-107, which are pending in this application and have been addressed here in this non-final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(703) 605-4252**. The examiner can normally be reached Monday thru Friday 8:00 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **(703) 308-1344**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.


Mark Fadok

Patent Examiner


JEFFREY A. SMITH
PRIMARY EXAMINER